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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,402	12/17/1999	SUBBARAO V. PONAKALA	2047.114	8828

7590 06/19/2002

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EXAMINER

WONG, LESLIE A

ART UNIT	PAPER NUMBER
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1761

12

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/465,402**

Applicant(s)  
**Ponakala et al.**

Examiner  
**Leslie Wong**

Art Unit  
**1761**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 21, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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The request filed on May 21, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/465402 is acceptable and a CPA has been established. An action on the CPA follows.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nofre et al (5480668).

Nofre et al disclose N-substituted derivatives of aspartame and that N-[N-(3,3-dimethylbutyl)-L- $\alpha$ -aspartyl]-L-phenylalanine 1-methyl ester is an extremely potent sweetening agent, where the agent may be used by itself or in combination with other sweetening agents (see entire patent, especially column 6, lines 16-26). Nofre et al also disclose that the agent may be used in a variety of products including chewing gum (see column 1, lines 10-14).

The claims differ as to the amounts employed and the specific use in chewing gums.

In the absence of a showing to the contrary, the amounts employed are seen to be no more than optimization which is well-within the skill of the art, see *In re Boesch* 205 USPQ 215.

The use of intense sweeteners in chewing gum products is notoriously well-known and the selection of chewing gum product is well-within the skill of the art and merely a matter of choice.

Once the art has recognized the use of N-[N-(3,3-dimethylbutyl)-L- $\alpha$ -aspartyl]-L-

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phenylalanine 1-methyl ester as a sweetening agent, then the use and manipulation of amounts for use in chewing gums would be no more than obvious and well-within the skill of the ordinary worker. The observation of still another beneficial result in an old process cannot form the basis of patentability, see *In re Jones* 1941 CD 686.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to use the sweeteners of Nofre et al in chewing gum products because it is well-known in the art that N-[N-(3,3-dimethylbutyl)-L- $\alpha$ -aspartyl]-L-phenylalanine 1-methyl ester is a powerful sweetening agent for use in foods and beverages.

Applicant's arguments filed May 21, 2002 have been fully considered but they are not persuasive for the reasons previously set forth in Paper Nos. 5 and 9.

Applicant argues that Nofre et al does not teach the use of N-[N-(3,3-dimethylbutyl)-L- $\alpha$ -aspartyl]-L-phenylalanine 1-methyl ester in chewing gum formulations and the prolongation of sweetness and flavor perception.

Applicant refers to the specification to provide support for unexpected results.

The specification data is insufficient to overcome the rejection of claims based upon Nofre et al as set forth in the last Office action for the following reasons.

1) The data is not commensurate in scope with the claims. The claims (i.e. claim 1) are very broad while the showing is specific.

2) It is not clear whether the disclosed differences are significant as data analysis is not

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provided. All of the Figures have previously been considered. A mere visual observation of differing trends does not support unexpected results.

3) It appears that persuasive data analysis in declaration/affidavit would result in the allowance of claims 19-27.

In the absence of unexpected results, it is not seen how the claimed invention differs from the teachings of the prior art. Applicant's claims are drawn to a combination of known components which produces expected results, see *In re Kerkhoven* 205 USPQ 1069 and *In re Gershon* 152 USPQ 602.

All of the claim limitations and arguments have been considered. None of them are seen as serving as basis for patentability.

No claim is allowed.

This is a CPA of applicant's earlier Application No. 09/465402. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

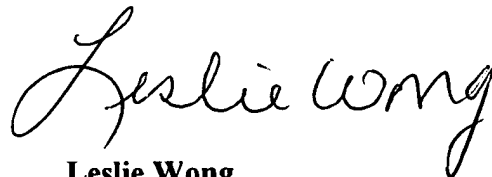
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 308-1979. The examiner can normally be reached on Tuesday-Friday.

The fax number for this Group is (703) 872-9310 for non-final responses and (703) 872-9311 for after-final responses.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script that reads "Leslie Wong".

**Leslie Wong**  
**Primary Examiner**  
**Art Unit 1761**

LAW  
June 17, 2002